

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Arthur L. Cleary et al.  
Application No. : 10/057,797  
Filed : 29 October 2001  
For : PRINTING SYSTEM WITH VACUUM TABLE  
Group Art Unit : 3654  
Examiner : SCOTT J. HAUGLAND

Mail Stop AF  
Commissioner for Patents  
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Alexandria, VA 22313-1450

REQUEST PURSUANT TO MPEP § 706.07(d) FOR  
RECONSIDERATION OF FINALITY OF REJECTIONS

Sir:

Pursuant to MPEP § 707.07(d), applicants respectfully request reconsideration of the finality of the rejections in the 6/27/2007 Office action. MPEP § 706.07(a) states that a second or subsequent action on the merits shall be final except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's claim amendments nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Applicant respectfully submits that the exception specified in § 707.07(a) applies in this case.

On 12/30/2005, the PTO mailed an Office action that rejected claims 2-15, 17 and 19-24 under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Office action stated that the term "contiguous sidewalls" in claims 21 and 23 was unclear. The 12/30/2005 Office action also rejected claims 2-15, 17, 19-21 and 23 as either anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103 based on

Yraceburu et al. U.S. Patent No. 6,409,332 (“Yraceburu”), and rejected claims 22 and 24 as obvious over Yraceburu in view of Ju U.S. Patent No. 5,806,992 (“Ju”).

On 5/1/2006, applicants filed a Reply that amended claims 21 and 23 solely to overcome the § 112, second paragraph rejections. In addition, applicants traversed the §§ 102 and 103 rejections. In particular, applicants asserted that claims 21 and 23 recited methods and apparatus that dispose a substantially flat porous sheet between a top surface of a vacuum table and a transport belt, but that Yraceburu did not describe or suggest anything disposed between the top surface of platen 311 and transport belt 32. Significantly, the amendments of claims 21 and 23 did not pertain in any way to the “flat porous sheet” limitation.

On 7/11/2006, the PTO mailed a final Office action that rejected all the pending claims under § 103 based on Yraceburu and Mittmeyer et al. U.S. Patent No. 5,232,141 (“Mittmeyer”). In particular, the 7/11/2006 Office action at 2 acknowledged the deficiency in the previous §102 and §103 rejections by asserting that “Yraceburu et al does not disclose that the porous sheet is positioned between the belt 32 and the vacuum table 307, 311.” The 7/11/2006 Office action then asserted that Mittmeyer supplied the element that Yraceburu failed to disclose.

On 10/6/2006, applicants filed a Notice of Appeal and Reply that traversed the § 103 rejections based on Yraceburu and Mittmeyer, and on 1/29/2007, applicants filed an Appeal Brief that similarly argued that the § 103(a) rejections were incorrect and should be reversed.

On 6/27/2007, the PTO mailed a final Office action that, in view of the Appeal Brief, reopened prosecution, and asserted new grounds of rejection. In particular, the 6/27/2007 Office action has rejected claims 19-21 and 23 under § 102(e) as anticipated by Wotton et al. U.S. Patent No. 6,336,722 (“Wotton”), and has rejected claims 2-15, 17, 22, 24 under § 103(a) as obvious over one or more of Wotton, Ju and Yraceburu. Surprisingly, the Examiner asserted that applicant’s 5/1/2006 amendment of claims 21 and 23 necessitated the new grounds of rejection, and made the Office action final.

Applicants respectfully disagree that the 5/1/2006 amendments, which were made solely to correct an indefiniteness problem in claims 21 and 23, somehow necessitated the new ground of rejection in the 6/27/2007 Office action. Indeed, as set

forth above, applicants have consistently traversed the various §102 and §103 rejections in each of their 5/1/2006 and 10/6/2006 replies, and in their 1/29/2007 Appeal Brief.

Further, the Examiner has acknowledged the deficiency of his previous §102 and §103 rejections by reopening prosecution in response to applicants' Appeal Brief, and asserting new grounds of rejection based on a reference that had never been substantively asserted in any previous Office action.

Accordingly, applicants respectfully submit that the new grounds of rejection asserted in the 6/27/2007 Office action, like the new grounds of rejection in the 7/11/2006 Office action, were neither necessitated by applicants' 5/1/2006 claim amendments nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) (of which there is none).

Accordingly, applicant respectfully submits that the finality of the rejections in the 6/27/2007 Office action was premature, and respectfully requests that the Examiner withdraw the finality of those rejections.

Respectfully submitted,

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